

J1046 U.S. PTO  
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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

AUG 6 - 1996

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

*Ex parte* WALTER DURCKHEIMER, DIETER BORMANN,  
EBERHARD EHLERS, ELMAR SCHRINNER and RENE HEYMES

Appeal No. 94-2004  
Application 07/551,615<sup>1</sup>

ON BRIEF

Before GOFFNEY, Acting Deputy Assistant Secretary of Commerce and Acting Deputy Commissioner of Patents and Trademarks,<sup>2</sup> HARKCOM, Vice Chief Administrative Patent Judge, GOLDSTEIN, COHEN, LYDDANE, JOHN D. SMITH and STAAB, Administrative Patent Judges, McKELVEY, Senior Administrative Patent Judge, and BARRETT, FLEMING, WEIFFENBACH and HANLON, Administrative Patent Judges.

WEIFFENBACH, Administrative Patent Judge.

<sup>1</sup>Application for reissue filed July 11, 1990, seeking to reissue of Patent No. 4,758,556, granted July 19, 1988, based on Application 05/891,850, filed March 30, 1978.

<sup>2</sup>Mr. Goffney was appointed as Assistant Commissioner for Patents. He is currently also serving as the Acting Deputy Assistant Secretary of Commerce and Acting Deputy Commissioner of Patents and Trademarks.

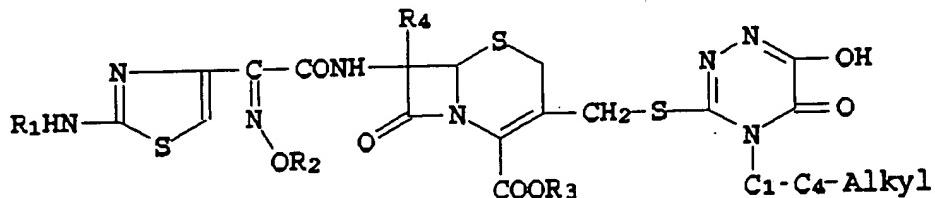
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## **DECISION ON APPEAL**

This appeal is from the examiner's final rejection of claims 1-17 which are all of the original claims in the patent sought to be reissued.

The invention is related to a syn compound of a cephem derivative for pharmaceutical formulations which are active against bacterial infections. Claim 1 is illustrative of the claimed invention:

### 1. A syn compound of the formula



wherein in the above formula  
R<sub>3</sub> is hydrogen, an alkali metal cation, or a carboxylic acid  
protecting group;  
R<sub>4</sub> is hydrogen or methoxy;  
R<sub>1</sub> is hydrogen or an amino protecting group; and  
R<sub>2</sub> is hydrogen or C<sub>1</sub>-C<sub>4</sub> alkyl.

Appellant, Hoechst Aktiengesellschaft, a corporation of the Federal Republic of Germany, seeks reissue of Patent No. 4,758,556 to withdraw a terminal disclaimer filed three years before the patent issued. Appellant states that at the time the

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terminal disclaimer was filed it was proper, but that it later became unnecessary when the examiner made a restriction requirement and divided the generic claims subject to the disclaimer into four separate and patentably distinct inventions. The patent was granted with the terminal disclaimer. Appellant seeks by reissue to have the terminal disclaimer withdrawn or nullified.

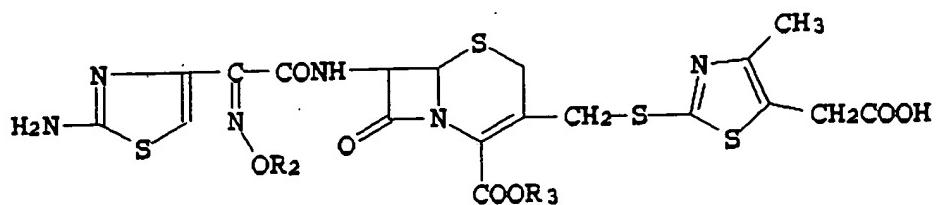
There are no outstanding rejections based upon prior art under 35 U.S.C. § 102 and/or § 103. Claims 1-17 stand rejected under 35 U.S.C. § 251 on the ground that since the terminal disclaimer was voluntarily submitted during the prosecution of the original patent, the reissue statute does not authorize the withdrawal of a terminal disclaimer once a patent issues. For reasons discussed *infra*, we will not sustain the rejection. However, we will enter a new ground of rejection of claims 1-17 under 35 U.S.C. § 251 on the ground that the claims are based on a defective reissue declaration.

#### Background

The application which matured into the patent sought to be reissued, Patent No. 4,758,556, was filed on March 30, 1978 with eleven claims. The examiner determined that Markush groups in the claims embraced multiple patentably distinct inventions. He made a telephone restriction requirement requesting an election of a single species to be examined on the merits. The patent applicants

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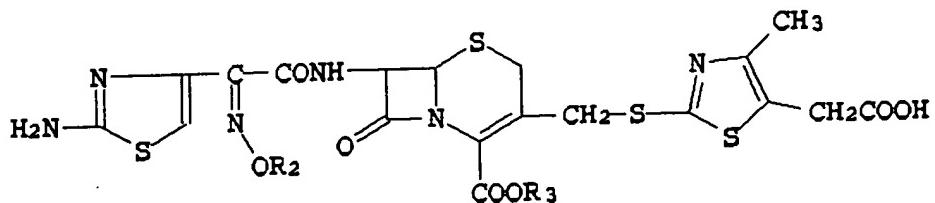
elected as the single species a compound having the following formula:



wherein R<sub>2</sub> is CH<sub>3</sub> and R<sub>3</sub> is H.

In a first Office action on the merits dated November 30, 1978, the examiner rejected all of the claims on numerous grounds, none of which are relevant to this decision. The patent applicants never responded to this action because on January 16, 1979, the examiner suggested a claim for interference. The patent applicants filed a timely response and copied the claim as suggested by the examiner and presented it as new claim 12. On May 1, 1979, the examiner suggested still another claim for the purpose of interference. Again, the patent applicants filed a timely response copying the suggested claim. This claim was presented as new claim 13. Two interferences were declared. The first interference was declared on September 25, 1979 with claim 13 as the count. The second interference was declared on November 5, 1979 with claim 12 as the count.

On July 21, 1980, the patent applicants filed a continuation application of their original patent application. The only claim in the continuation application was the species elected in the original patent application, namely, a compound having the following formula



wherein R<sub>2</sub> is CH<sub>3</sub> and R<sub>3</sub> is H. The continuation application was examined by another examiner in the same examining group and allowed with the single claim. The continuation application issued on July 14, 1981 as Patent No. 4,278,793. On February 13, 1981, the second interference was dissolved as to the patent applicants. On April 28, 1981, the patent applicants filed an amendment copying claims from a patent to Katner, Patent No. 4,200,745, which had issued on April 29, 1980. The amendment was filed for the purpose of provoking an interference with the Katner patent.<sup>3</sup> On January 21, 1982, the examiner held that no interference would be declared because the copied claims were not patentable to the patent

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<sup>3</sup>The Katner patent was not involved in either of the two previously declared interferences.

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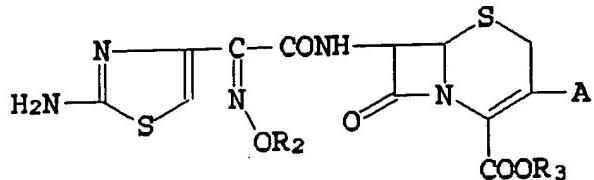
applicants since the claim did not comply with the written description requirement of 35 U.S.C. § 112.

On February 12, 1982, the first interference was dissolved as to the patent applicants. On May 24, 1982, the patent applicants filed an amendment copying still another claim from the Katner patent for the purpose of provoking an interference. On July 30, 1982, the examiner resumed *ex parte* examination and issued a written restriction requirement requiring the patent applicants to elect between an undefined group of process claims and an undefined group of composition claims and to further elect a single disclosed and supported species to be examined on the merits. The examiner did not require that the patent applicants adhere to the original election of species made in the Office action dated November 30, 1978. Applicants elected the composition claims and a species different from the originally elected species.

In December 1984, the examiner held an oral interview with counsel for the patent applicants. At that interview, Patent No. 4,278,793 was discussed. Because the parties were of the opinion that the pending claims generically covered the single claim in Patent No. 4,278,793, it was agreed that a terminal disclaimer should be filed. Accordingly, a proper terminal disclaimer was filed on January 17, 1985 disclaiming the terminal portion of any patent granted on the application which would extend beyond July 14, 1998, the expiration date of Patent No. 4,278,793.

Prosecution continued in the application until January 21, 1987 when an interference was declared between the application and the Katner patent. On July 7, 1987, a decision favorable to applicants in the Katner interference was made by the Board of Patent Appeals and Interferences. The following generic claim was present in the application when it was returned to the examiner:

42. A cephem compound of the formula



wherein

R<sub>2</sub> is C<sub>1</sub>-C<sub>4</sub>-alkyl or C<sub>1</sub>-C<sub>4</sub>-alkyl substituted by carboxyl, and the group -OR<sub>2</sub> is in the syn-position;

R<sub>3</sub> is hydrogen, a physiologically acceptable ester group, or a physiologically acceptable cation; and

A is -CH<sub>2</sub>Y, wherein

Y is pyridinium bound to -CH<sub>2</sub>- by the nitrogen atom thereof, or wherein

Y is -SR<sub>5</sub>, wherein

R<sub>5</sub> is tetrazolopyridazinyl, purinyl, triazinyl, or triazinyl which is partially or completely hydrogenated, or wherein

R<sub>5</sub> is a 5- or 6-membered heterocycle which is thiazolyl, oxadiazolyl, triazolyl, tetrazolyl, pyrimidinyl, triazinyl, or thiadiazolyl, or is such a heterocycle which is partially or completely hydrogenated, said heterocycle or partially or completed hydrogenated heterocycle being substituted by carboxyloweralkyl, trifluoromethyl, aminoloweralkyl, acetylaminoloweralkyl, loweralkyloxycarbonyl-loweralkylcarbox-

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amido, hydroxy, oxo, oxido, carboxy, furyl, thienyl, thiazolyl, or pyridyl, and also by lower alkyl if said heterocycle or partially or completely hydrogenated heterocycle is triazinyl or partially or completely hydrogenated triazinyl.

There is no dispute that this claim was generic to the species claim in Patent No. 4,278,793 and that the terminal disclaimer was needed to obviate any obviousness-type double patenting rejection. When ex parte prosecution was resumed on September 9, 1987, the examiner made a written restriction requirement and grouped the inventions as follows:

Group A. In claim 42 compounds wherein the variable "A" is a "pyridinium" system.

Group B. In claim 42 compounds when the variable R<sub>5</sub> may be a "five membered" hetero system.

Group C. In claim 42 compounds wherein the variable R<sub>5</sub> may be a "six membered hetero system". As the art has developed each group has become patentably distinct.

The examiner held that the inventions as grouped above were separate and patentably distinct inventions and required the patent applicants to elect one invention to be examined.

The patent applicants filed a timely response electing Group C, without traverse. Applicants canceled claim 42 and presented new claims limited to Group C compounds. Other amendments were made by adding new claims and canceling or amending existing

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claims such that three additional sets of new claims were presented: the first set was directed only to Group A compounds, the second limited only to Group B compounds, and a third set was drawn to a fourth invention which the examiner subsequently held to be new Group D.<sup>4</sup> On January 28, 1988, the examiner closed prosecution and by examiner's amendment canceled all claims to the non-elected inventions. The application was passed to issue and issued as Patent No. 4,758,556 on July 19, 1988. On the record before us, the patent applicants did not make any effort to seek to withdraw or remove the terminal disclaimer before the patent issued.

On April 12, 1990, the patentees filed a request for certificate of correction under 37 CFR § 1.323 to delete the terminal disclaimer notice in the patent arguing that the terminal disclaimer had become unnecessary and that reference to it should be deleted from the patent. On June 13, 1990, the request was denied on the ground that "the request would require reexamination of the application" because "the issue of whether any of claims 1-17 of Patent No. 4,758,556 would be subject to rejection based upon

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<sup>4</sup>In their response to the restriction requirement (Paper No. 69 in Patent No. 4,758,556), applicants recommended modifying the restriction to include a further "Group D" because it was not clear whether one of the claims subject to restriction was a substituted 6-membered heterocyclic ring or a compound which was not defined by any of Groups A, B or C. The examiner in his amendment (Paper No. 71 in Patent No. 4,758,556) agreed with the suggestion and modified his restriction requirement to include a new Group D and concluded that "[e]ach group A, B, C and D will support separate patents."

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the ground of obvious type double patenting over Patent No. 4,278,793, is raised by the request." The Office of the Deputy Assistant Commissioner for Patents denied the patentees' request for reconsideration on the ground that

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" by Judge Rich in *In re Jentoft*<sup>[5]</sup>, [392 F.2d 633, 639,] 157 USPQ 363, 368 (footnote 6) (1988) [sic: CCPA 1968], there is no statutory prohibition against nullifying or otherwise cancelling the effectiveness of a terminal disclaimer. Accordingly, the Office has granted petitions under 37 CFR 1.182 to withdraw or nullify a terminal disclaimer only when the public has not had an opportunity to rely on the terminal disclaimer.

In this instance, the terminal disclaimer took effect when the patent issued, and the public has had an opportunity to rely on the terminal disclaimer. Accordingly, the mistake in disclaimer.

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<sup>5</sup> In its opinion, the *Jentoft* court was querying how the Office normally treats double patenting issues, which the court determined was a two step process, namely, determining first whether there would be double patenting without the terminal disclaimer and then whether the disclaimer obviates the double patenting. To this, the court made the following remark in footnote 6:

One might almost take the filing of a terminal disclaimer in response to a "double patenting" rejection to be a tacit admission that, without it, there would be double patenting except for the observation we have made in these cases that applicants frequently like to argue both issues. It is an unhappy circumstance to file a terminal disclaimer in a case where, on appeal, it turns out to have been unnecessary.

While many inferences could be drawn from this statement, it is dicta which is not relevant to this case herein since we agree with appellant that the court did not hold that the "unhappy circumstance" cannot be remedied by reissue.

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filling the terminal disclaimer is not "of minor character" as required by 37 CFR 1.323.<sup>6</sup>

On July, 11, 1990, this reissue application was filed seeking to withdraw the terminal disclaimer. In its reissue declaration, appellant states that

Although the patent was reviewed upon its issuance, the fact that the Terminal Disclaimer is unnecessary and inappropriate in this case was only discovered this year during an in depth review of the complete prosecution of the application.

The examiner rejected all of the reissue claims under 35 U.S.C. § 251. The examiner based his decision on the policy set forth in section 1490 of the *Manual of Patent Examining Procedure* (hereinafter MPEP) which states, in part, that "[a]lthough the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors ... [and that] reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent." The examiner did not reject any of the claims on the ground of obviousness-type double patenting over Patent No. 4,278,793. The claims stand rejected on the ground that the reissue statute does not authorize the withdrawal of a terminal disclaimer once a patent

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<sup>6</sup>37 CFR § 1.323 provides, in part, that "Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the fee set forth in §1.20(a), issue a certificate, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination."

issues because the reissue statute prohibits extension of the term of the issued patent and because public policy and the recapture rule prohibit the withdrawal of a terminal disclaimer.

**Opinion**

There are two facts in this case that are not in dispute. First, the terminal disclaimer was proper at the time it was filed because both the examiner and the patent applicants agree that the generic claims then pending in the patent sought to be reissued covered the single claim in Patent No. 4,278,793. Second, the terminal disclaimer later became unnecessary because of the examiner's restriction requirement and the examiner's amendment cancelling all subject matter which would have been subject to an obviousness-type double patenting rejection over the single claim in Patent No. 4,278,793.<sup>7</sup>

The purpose for which the patent applicants filed and recorded the terminal disclaimer appears to be the need to obviate a potential obviousness-type double patenting rejection. At the time the terminal disclaimer was filed, there were generic claims which the patent applicants believed were patentably indistinct from the single claim in Patent No. 4,278,793. *In re Kaye*, 332

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<sup>7</sup>The examiner agrees with appellant that the terminal disclaimer is unnecessary. On page 2 of the answer, the examiner states, "There is no controversy that the terminal disclaimer became unnecessary in view of the requirement for restriction ...."

F.2d 816, 819, 141 USPQ 829, 831 (CCPA 1964); *In re Robeson*, 331 F.2d 610, 615, 141 USPQ 485, 489 (CCPA 1964). However, approximately 2½ years after the terminal disclaimer was filed, the examiner determined that the generic claims were directed to or covered four separate and patentably distinct inventions. In response to the restriction requirement, the patent applicants elected an invention which was patentably distinct from the single claim in Patent No. 4,278,793. None of the claims of the issued patent would have been subject to an obviousness-type double patenting rejection because the claims in the patent are limited to a compound having a 6-membered heterocycle whereas the claim in Patent No. 4,278,793 is a compound having 5-membered heterocycle (this compound being within non-elected Group B). Unequivocally, the restriction requirement and the examiner's amendment cancelling all claims to the non-elected inventions obviated the purpose for which the terminal disclaimer had been originally filed.<sup>8</sup>

Our reviewing court has consistently held that the purpose of the reissue statute, 35 U.S.C. § 251, is to allow patentees to correct errors due to accident, inadvertence or

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<sup>8</sup>Appellant states that the PTO played a part in the mistake regarding the terminal disclaimer in that the examiner did not *sua sponte* take action to withdraw the terminal disclaimer after making the restriction requirement. See pages 10, 11, and 19 of the supplemental brief; pages 33-34 of the reply brief; and pages 8-9 of the surreply brief. Assuming that it could be established that the examiner made a mistake, a mistake by the examiner is not an "error" under 35 U.S.C. § 251. *Ex parte Ziherl*, 116 USPQ 162 (Bd. App. 1958).

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mistake without any deceptive intention. *In re Bennett*, 766 F.2d 524, 528, 226 USPQ 413, 416 (Fed. Cir. 1985) (in banc); *Ball Corp. v. United States*, 729 F.2d 1429, 1439 n.28, 221 USPQ 289, 296 n.28 (Fed. Cir. 1984); *In re Hay*, 534 F.2d 917, 919, 189 USPQ 790, 791 (CCPA 1976); *In re Byers*, 230 F.2d 451, 109 USPQ 53 (CCPA 1956). The statute is remedial and should be liberally construed. *Brenner v. The State of Israel*, 400 F.2d 789, 158 USPQ 584 (D.C. Cir. 1968). As stated by the court in *In re Willingham*, 282 F.2d 353, 354-55, 127 USPQ 211, 214 (CCPA 1960):

The reissue provisions of the Patent Act of 1952, like the reissue provisions of the earlier patent statutes, are remedial in nature. They are based on the fundamental principles of equity and fairness and should be so applied to the facts of any given case that justice will be done both to the patentee and to the public.

In order for appellant to be entitled to reissue, appellant must establish an error without deceptive intention.<sup>9</sup> For reasons hereinafter set forth in a new ground of rejection pursuant to the provisions of 37 CFR § 1.196(b), we find that appellant's reissue declaration is defective under 35 U.S.C. § 251 in that,

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<sup>9</sup>In his answer, the examiner believed that the question to be decided in this case was whether the reissue statute, 35 U.S.C. § 251, authorizes the withdrawal of a terminal disclaimer, submitted voluntarily, even though the terminal disclaimer has become unnecessary in view of further action taken in the case. As we see it, the question is not whether the Commissioner has authority under the statute to withdraw the terminal disclaimer, but whether the original patent is defective through error without deceptive intention. See *In re Weiler*, 790 F.2d 1576, 229 USPQ 673 (Fed. Cir. 1986); *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977).

inter alia, it fails to set forth an error. However, appellant has stated an error in the appeal brief and the supplemental brief as being the failure to petition under 37 CFR § 1.182 or otherwise to request during the prosecution of the Patent No. 4,758,556 to have the terminal disclaimer canceled, withdrawn or nullified.<sup>10</sup> At the time Patent No. 4,758,556 was granted, the MPEP did not provide any guidance for withdrawing an unnecessary terminal disclaimer.<sup>11</sup>

However, in 1987 and 1988, the provisions of 37 CFR § 1.182 were

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<sup>10</sup>Appellant states in its appeal brief and supplemental brief that "the error during the prosecution of [the patent sought to be reissued] was in not petitioning under 37 C.F.R. §1.182 or otherwise requesting to cancel, withdraw or nullify the terminal disclaimer after the September 10, 1987 Office Action or the January 22, 1988 Examiner's Amendment when the Examiner had mooted the need for the terminal disclaimer." See the paragraph bridging pages 7 and 8 of the appeal brief and see also the top of page 9 of the supplemental brief.

<sup>11</sup>Section 1490 of the MPEP, 6th Ed., January 1995 provides, in pertinent part, that

While the filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968), there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues. Since the terminal disclaimer would not take effect until the patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from this unhappy circumstance may be available by way of petition or by refiling the application.

Under appropriate circumstances, consistent with the orderly administration of the examination process, the nullification of a recorded terminal disclaimer may be addressed by filing a petition under 37 CFR 1.182 requesting withdrawal of the recorded terminal disclaimer. Petitions seeking to reopen the question of the propriety of the double patenting rejection that prompted the filing of the terminal disclaimer have not been favorably considered. The filing of a continuing application, while abandoning the application in which the terminal disclaimer has been filed, will typically nullify the effect of a terminal disclaimer.

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available to petition for matters not specifically provided for in the rules and regulations. Among the known types of petitions under 37 CFR § 1.182 are petitions to expunge papers from patent application files.<sup>12</sup>

Considering all of the facts of record in this case and the prosecution history of the patent sought to be reissued, we conclude that the record establishes that the terminal disclaimer became unnecessary as a result of the examiner's action and that an error within the meaning of 35 U.S.C. § 251 could have occurred by the patent applicants' or their appointed representative's failure to petition or to take some other action<sup>13</sup> to nullify or expunge the terminal disclaimer from the application file before Patent No. 4,758,556 was granted.

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<sup>12</sup>37 CFR § 1.182 states, in part, that "[a]ll cases not specifically provided for in the regulations of this part [Part 1, rules of practice in patent cases] will be decided in accordance with the merits of each case by or under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing." See also Sections 724.05 and 1002.02(a) of the MPEP, 5th Ed., Rev.3, May 1986, which provided for expunging papers from patent application or patent files by petition under 37 CFR § 1.182. All registered practitioners are expected to know the rules and how to apply them.

<sup>13</sup>At the time of the allowance of the claims in Patent No. 4,758,556, the patent applicants could have filed a continuation application without the terminal disclaimer and abandoned the allowed application. Section 1490 of the MPEP, 5th Ed., 1987 states that

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer. For example, a terminal disclaimer filed in a parent application has no effect on a continuing application claiming filing date benefits of the parent application under 35 U.S.C. 120.

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The examiner's position for rejecting the claims in this application for reissue is based on Office policy set forth in section 1490 of the MPEP which provides, in pertinent part, that

Although the remedial nature of reissue (35 U.S.C. 251) is well recognized, reissue is not available to correct all errors. It has been the Office position that reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent. First, the reissue patent statute only authorizes the Commissioner to reissue a patent "for the unexpired part of the term of the original patent". Since the granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, reissue under these circumstances would be contrary to the statute. Second, the principle against recapturing something that has been intentionally dedicated to the public dates back to *Leggett v. Avery* [citation omitted]. The attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle. Finally, applicants have the opportunity to challenge the need for a terminal disclaimer during the prosecution of the application that issues as a patent. "Reissue is not a substitute for Patent Office appeal procedures." *Ball Corp. v. United States* [citation omitted]. Where applicants did not challenge the propriety of the examiner's obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251. *Ex parte Anthony* [citation omitted].

To the extent that this section of the MPEP is interpreted to mean that reissue is never available for whatever reason to withdraw or

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otherwise nullify the effect of a terminal disclaimer recorded in an issued patent, we find this interpretation to be inconsistent with the provisions of 35 U.S.C. § 251. The reissue statute, in pertinent part, provides that

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, ... by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

The statute does not specifically exclude certain errors as not being correctable by reissue. If a reissue oath or declaration presents facts and circumstances to establish that the filing of a terminal disclaimer or the failure to take appropriate action to remove a terminal disclaimer was an error without any deceptive intention within the meaning of the 35 U.S.C. § 251, the reissue statute clearly mandates that the Commissioner shall reissue the original patent for the unexpired term of the original patent if the original patent is surrendered and payment of the appropriate fee is made.

MPEP section 1490 sets forth three reasons why "reissue is not available to withdraw or otherwise nullify the effect of a terminal disclaimer recorded in an issued patent." The first

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reason is that the "granting of a reissue patent without the effect of a recorded terminal disclaimer would result in extending the term of the original patent, [and granting] reissue under these circumstances would be contrary to the statute." We are in full agreement with appellant's statement that

A terminal disclaimer does not alter "the term of the original patent". Rather, a terminal disclaimer is only a "disclaim[er] [of a] terminal part of the term, of the patent granted or to be granted.<sup>14</sup>

At the time the patent sought to be reissued was granted, 35 U.S.C. § 154 stated that "[E]very patent shall contain ... a grant to the patentee, his heirs or assigns, for the term of seventeen years, ... of the right to exclude others from making, using, or selling the invention ...." (Emphasis ours.) The statute did not make any exception for shortening the term of a patent with regard to terminal disclaimers 35 U.S.C. § 253.<sup>15</sup> We agree with appellant

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<sup>14</sup>See page 15 of the reply brief.

<sup>15</sup>Terminal disclaimers are provided for in the second paragraph of 35 U.S.C. § 253. The statute provides that

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing and recorded in the Patent and Trademark Office, and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

(continued...)

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that the phrase "unexpired term of the original patent" in section 251 refers to the remainder of the 17 year term granted under section 154. As pointed out by appellant, the patent statute is a unified statute and all provisions must be read in harmony. *In re Bennett*, 766 F.2d at 528, 226 USPQ at 416. Thus, the patent sought to be reissued was granted for a term of seventeen years with the terminal portion being disclaimed beginning on the date the seventeen year term of Patent No. 4,278,793 lapses. For the aforementioned reasons, we do not see that a reissue in this case would extend the term of the original patent sought to be reissued under 35 U.S.C. § 251.

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<sup>15</sup>(...continued)

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

35 U.S.C. § 154 is directed to the contents and term of a patent. The statute was amended on December 8, 1994, effective June 8, 1995 to extend the term of a patent to 20 years. The following statute was in effect at the time Patent No. 4,758,556 was granted:

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States and, if the invention is a process, of the right to exclude others from using or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

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This case presents an unique set of facts and circumstances wherein the claims which were secured by the filing of the terminal disclaimer were cancelled before the patent was granted. Since none of the claims in the patent grant were secured by the filing of the terminal disclaimer, the owner of the patent should be entitled to enforce the claims for the full term of the patent. Cf. *Autogiro Co. of America v. United States*, 384 F.2d 391, 410, 155 USPQ 697, 713 (Ct. Cl. 1967).

The second reason for denying reissue set forth in MPEP section 1490 is that any "attempt to restore that portion of the patent term that was dedicated to the public to secure the grant of the original patent would be contrary to this recapture principle." The facts in this case do not involve recapture. The reissue applicant is not seeking to recapture the claims cancelled as a result of the restriction requirement or to add new claims which would be generic to the claimed subject matter in Patent No. 4,200,745 and subject to an obviousness-type double patenting rejection. This application for reissue was filed without any changes to the original patent claims. Moreover, for reasons already stated, this case does not involve recapture or restoration of the patent term. Accordingly, recapture is not an issue under the facts presented by this case.

The third reason for denying reissue set forth in MPEP section 1490 is that "[w]here applicants did not challenge the

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propriety of the examiner's obvious-type double patenting rejection, but filed a terminal disclaimer to avoid the rejection, the filing of the terminal disclaimer did not constitute error within the meaning of 35 U.S.C. 251." A decision of the Board in *Ex parte Anthony*, 230 USPQ 467 (Bd. App. 1982), *aff'd. memo.*, 770 F.2d 182 (Fed. Cir. 1985) (non-precedential) is cited as controlling.

The facts in *Ex parte Anthony* are clearly distinguishable over this case. In *Anthony*, an application for reissue of a patent was filed to remove a terminal disclaimer which had been filed during the prosecution of the patent to obviate an obviousness-type double patenting rejection of all of the patent claims. During the prosecution of the patent, the patent applicant never pointed out any error in the examiner's double patenting rejection. At pages 469-70 of the decision, the PTO Board of Appeals held that

The deliberate filing of the terminal disclaimer to overcome the [obviousness-type double patenting] rejection cannot now be considered as such an error as contemplated by 35 USC 251 to permit the reissuance of the patent in order to cancel or withdraw the terminal disclaimer.

Under the circumstances here present, the reissue is not to correct [a] mere formal matter. The terminal disclaimer which is now attempted to be nullified was of substantive significance which had a direct bearing in the issuance of the original patent. Nor is the reissue being sought to correct a defect in the specification or drawing or because the patentee is claiming more or less than he had a right to claim in the patent. The purpose of the reissue here, in effect, is to nullify

a deliberate action taken in order to remove an outstanding rejection, which rejection, as a consequence of the action taken, was withdrawn. (Emphasis ours.)

In the record before us, the examiner has stated that the claims in the patent sought to be reissued would not have been subject to an obviousness-type double patenting rejection covered by the terminal disclaimer filed in 1985.<sup>16</sup> No such rejection has been made by the examiner in this reissue application. Considering all of the facts of record, although in the original patent there was a need to challenge the need for a terminal disclaimer after the examiner cancelled claims to the non-elected inventions, there was no apparent obviousness-type double patenting rejection to challenge. Therefore, contrary to the holding in *Ex parte Anthony*, the terminal disclaimer did not have a direct bearing on the patent claims ultimately appearing in Patent No. 4,758,558.

MPEP section 1490 also relies on *Ball Corp. v. United States, supra*, for the proposition that reissue is not a substitute for failure to use Patent and Trademark Office procedures during the prosecution of the original patent to challenge the need for a terminal disclaimer. Whether or not the patent applicants had opportunity to challenge the need for a terminal disclaimer has yet to be determined since the reissue declaration, for reasons set

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<sup>16</sup>See footnote 7.

forth in the new ground of rejection, *infra*, fails to set forth sufficient facts upon which to make a determination that an error due to accident, inadvertence or mistake without deceptive intention was made that deprived the patent applicants of the opportunity to challenge the necessity of a terminal disclaimer during the prosecution of the original patent. However, inadvertent error for failure to take advantage of an opportunity of or to follow Office procedure before a patent issues is not *per se* a ground for denying a reissue. See *A.F. Stoddard & Co., Ltd. v. Dann*, 564 F.2d 556, 195 USPQ 97 (D.C. Cir. 1977) (reissue was granted for failure to name the correct inventor, the patent was amended to change the originally named sole inventor to another sole inventor); *Sampson v. Commissioner of Patents and Trademarks*, 195 USPQ 136 (D.D.C. 1976) (reissue was granted for failure to include the dates, serial numbers, and relationships of prior patent applications in the original patent specification as required by 35 U.S.C. § 120 to obtain the benefit of an earlier filing date); *Brenner v. The State of Israel*, *supra* (reissue was granted for failure to file a certified copy of the original foreign patent application as required by 35 U.S.C. § 119 for a claim for priority). It is evident from these cases that the term error under section 251 is to be construed broadly. See also *In re Wadlinger*, 496 F.2d 1200, 1207-08, 181 USPQ 826, 832 (CCPA 1974); *ESY*

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*In re Richman*, 409 F.2d 269, 273-75, 161 USPQ 359, 362-63 (CCPA 1969).

In view of the facts presented herein and for all of the foregoing reasons, we conclude that reissue of the patent should not be barred if the reissue applicant satisfies the requirements of 35 U.S.C. § 251 and the regulations pertaining thereto. Accordingly, we will not sustain the examiner's rejection claims 1-17 under 35 U.S.C. § 251. Nevertheless, we enter the following new ground of rejection of the claims under 35 U.S.C. § 251 for other reasons.

#### New Ground of Rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 1-17 are rejected under 35 U.S.C. § 251 on the ground that the reissue declaration does not set forth an error without any deceptive intention which would warrant reissue of Patent No. 4,758,556.

Paragraph 8 of appellant's reissue declaration states that Patent No. 4,758,556 is partly inoperative by reason of the patent applicants claiming less than they had a right to claim in the patent. In particular, paragraph 8 of the declaration states that

8. U.S. Patent No. 4,758,556 is partly inoperative because of error without any deceptive intention on the part of the

applicants as set forth in detail below [presumably paragraphs 9 to 16]. U.S. Patent No. 4,758,556 is partly inoperative by reason of the patentees claiming less than they had a right to claim in the patent by reason of a Terminal Disclaimer which is unnecessary and inappropriate for this patent. The reasons that the Terminal Disclaimer is unnecessary and inappropriate are particularly specified below [presumably paragraphs 9 to 16]. That Terminal Disclaimer disclaimed the term of U.S. Patent No. 4,758,556 beyond the expiration date of U.S. Patent No. 4,278,793. The errors relied upon, and how they arose or occurred, are particularly specified below [presumably paragraphs 9 to 16].

Paragraphs 9 to 14 of the declaration summarize the facts leading up to the mailing of the examiner's amendment in Patent No. 4,758,556. These facts establish that applicants filed a proper terminal disclaimer to obviate a potential obviousness type double patenting rejection of the broad generic claims over the single species claim in Patent No. 4,278,793, that the generic claims were subjected to a restriction requirement, that applicants elected without traverse the 6-membered heterocycle, and that the examiner by amendment canceled claims directed to the non-elected invention.

Paragraphs 15 and 16 then recite that

15. Since the allowed claims were directed to the 6-membered heterocycle containing compounds, there was no need for a Terminal Disclaimer over the '793 patent which contained a claim covering a patentably distinct 5-membered heterocycle containing compound. Accordingly, U.S. Patent No. 4,758,556 should be reissued to withdraw the Terminal Disclaimer as it pertains to the patentably distinct claims.

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16. Applicants verily believe the original Letters Patent No. 4,758,556 to be partly inoperative without any deceptive intention on the part of applicants.

Paragraphs 9 to 16 do not establish an error upon which a reissue can be based. The fact that the terminal disclaimer was unnecessary is not an error because the filing of the terminal disclaimer, the requirement for restriction, the election made by applicants and the examiner's amendment were all appropriate at the time the actions were taken.

In the appeal brief and supplemental brief, appellant states that "the error ... was in not petitioning under 37 C.F.R. §1.182 or otherwise requesting to cancel, withdraw or nullify the terminal disclaimer after the September 10, 1987 Office Action or the January 22, 1988 Examiner's Amendment when the Examiner had mooted the need for the terminal disclaimer."<sup>17</sup> This error is not set forth in the reissue declaration. If this is the error, then the reissue declaration must state how the error arose or occurred to establish that the error was due to accident, inadvertence or mistake and occurred without any deceptive intention.

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<sup>17</sup>See the paragraph bridging pages 7 and 8 of the appeal brief. See also the top of page 9 of the supplemental brief.

In paragraph 17 of the reissue declaration, appellant states that

Although the patent was reviewed upon its issuance, the fact that the Terminal Disclaimer is unnecessary and inappropriate in this case was only discovered this year during an in depth review of the complete prosecution of the application.

This statement also does not establish an error. The fact that the terminal disclaimer was discovered as being "unnecessary and inappropriate" after the patent issued is not the error, but the result of a possible error. Appellant states that "the patent was reviewed upon its issuance." It is not clear whether the patent was reviewed upon issuance by the examiner or after the patent was granted. This statement does not point out why the terminal disclaimer was not discovered as being unnecessary before the issuance of the patent. Of particular importance is why no effort was made by the patent applicants or their appointed legal representatives to have the disclaimer expunged or withdrawn prior to the granting of the patent. Appellant's statement that "the fact that the Terminal Disclaimer is unnecessary and inappropriate in this case was only discovered this year during an in depth review of the complete prosecution of the application" falls short of showing when and by whom it was discovered that the terminal disclaimer was unnecessary. Also, the term "this year" is

ambiguous and does not establish with certainty a date or the specific year when the discovery was made.

In responding to this rejection, appellant must set forth all relevant facts and circumstances surrounding how, when and why the terminal disclaimer was discovered to have been unnecessary and who discovered the error. The response must also set forth all of the facts and circumstances surrounding the review of the patent application between the time the examiner indicated allowability of the application and the granting of the patent. The response must identify when and who reviewed the application file, what was reviewed, the results of the review with regard to the terminal disclaimer, and if the terminal disclaimer was noted, an explanation as to why no effort was made by applicants or their legal counsel to have the terminal disclaimer removed or expunged before Patent No. 4,758,556 was granted. All of this information will be necessary for the examiner to make a proper determination of whether there was an error without deceptive intention within the meaning of the reissue statute.

The reissue declaration is also deficient in that it does not comply with the requirements of 37 CFR § 1.172. The reissue declaration is signed by an officer of the assignee of the patent. The assignee declarant states that the patent sought to be reissued is partly inoperative by reason of the patent applicants claiming less than they had a right to claim in the patent. Although the

horizontal scope of the original patent claims has not changed, this is interpreted to mean that appellant is seeking to enlarge the vertical scope of the claims or the period of enforceability of the original patent.<sup>18</sup> This reissue application was filed less than two years after the grant of the original patent. The reissue statute permits the granting of reissues to broaden the scope of claims, whether vertical scope or horizontal scope, if an application for reissue is filed within two years after the date the original patent was granted. When the scope is enlarged, 37 CFR § 1.172 requires that the reissue oath must be signed and sworn to or a declaration made by the inventors, and not the assignee (except as otherwise provided for in 37 CFR §§ 1.42, 1.43 and 1.47, none of which appear to be applicable here). Accordingly, any supplemental reissue oath or declaration filed in this application for reissue must be signed and sworn to by the inventors and must

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<sup>18</sup>In the paragraph bridging pages 12 and 13 of the appeal brief, appellant states that "[t]he present circumstances are analogous to the situation where the claims as granted are narrower than what applicants were entitled to claim." The Board in *Ex parte Anthony*, 230 USPQ at 470, discussed enlarging the scope of claims in terms of the vertical scope and stated that

"We are also of the view that the reissue application is not here proper since, in effect, the granting of the reissue would enlarge the scope of the claims of the original patent. The claims would be able to be sued upon for a longer period than would the claims of the original patent. Therefore, the vertical scope, as opposed to the horizontal scope (where the subject matter is enlarged), would be enlarged. Since this application was filed more than two years from the grant of the original patent, the reissue is barred by section 251."

also be accompanied by the written assent of the assignee pursuant to the rule.

#### Conclusion

For the foregoing reasons, we will not sustain the examiner's rejection of claims 1-17 under 35 U.S.C. § 251 based on the ground that the reissue statute does not authorize the withdrawal of a terminal disclaimer. We enter a new ground of rejection of claims 1-17 under 35 U.S.C. § 251 based on a defective reissue oath.

We must emphasize that no inferences should be drawn from this decision beyond the facts presented herein. Our decision in this case is based solely on the facts of record. In addition, we must emphasize that we have made no determination in this opinion as to whether appellant can effectively withdraw a terminal disclaimer by merely filing this reissue application and requesting through its reissue declaration that the terminal disclaimer be withdrawn.<sup>19</sup> Whether or not the terminal disclaimer has been effectively withdrawn is a procedural matter to be decided by the examiner.<sup>20</sup>

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<sup>19</sup>Section 1490 of the MPEP, 6th Ed., January 1995, sets forth the procedures for withdrawing a recorded terminal disclaimer.

<sup>20</sup>The provisions under 37 CFR § 1.182 would appear to be available for filing in the patented file a petition to expunge the terminal disclaimer.

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**Request for Reconsideration**

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within **one month** from the date of the decision. 37 CFR § 1.197. Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire **two months** from the date of this decision. No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**REVERSED - 37 CFR § 1.196(b)**

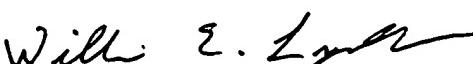
  
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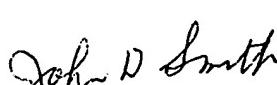
  
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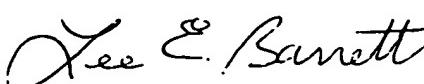
  
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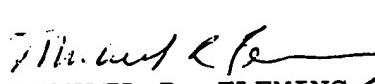
  
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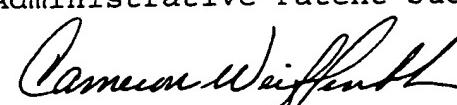
  
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